

### **REMARKS**

This responds to the Decision on Appeal mailed on May 22, 2007.

Claims 1, 9 and 14 are amended, claims 2, 8, 10, 13, 15 and 17 are canceled without prejudice, and no claims are added; as a result, claims 1, 7, 9, 11, 12, 14 and 16 are now pending in this application.

#### **§103 Rejection of the Claims**

Following the Decision on Appeal the following rejections were affirmed.

Claims 1-2 and 7-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over NOWTHIS.COM

Claims 1-2 and 7-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Epinions ([www.epinions.com](http://www.epinions.com), October 12, 1999) in view of Salas et al. (U.S. 6,230,185).

Claims 1-2 and 7-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Klingman (U.S. 5,950,172).

Applicant is aware of and concedes the *res judicata* effect of the Board of Appeals Decision of May 21, 2007 in this application. Notwithstanding the fact that the Board decision is the "law of the case," Applicant suggests that the amendments proposed to the claims and the arguments below justify reconsideration and allowance of the amended claims and their dependent claims.

Applicants have amended claim 1 to include the limitations of dependent claims 2 and 8. Applicants have amended claim 9 to include the limitations of dependent claims 10 and 13. Applicants have amended claim 14 to include the limitations of dependent claims 15 and 17. Applicant submits that amended claims 1, 9 and 14 are patentable over the materials as cited and applied by the Examiner, as partially affirmed by the Board of Appeals. Because amended claims 1, 9 and 14 are patentable for reasons analogous to those discussed below relative to claim 1, those claims are not separately further discussed herein.

Although the Board affirmed the various obviousness rejections of the pending claims, the Examiner's contention that all pending claims of the application were anticipated by NowThis was not sustained by the Board.

The affirmance of the obviousness rejection based in part upon NowThis was also based on the Examiner's taking of "official notice of the notoriety of one vote per person."

Specifically, the Board concluded that:

"...the nature of the subject matter being voted upon in NowThis suggests the count was incremented if the stored number of indications did not exceed one indication for the review from the user<sup>1</sup>".

Even if NowThis were interpreted to suggest that a one vote per person rule be applied to votes, nothing in the cited NowThis document shows or suggests the sorting operations of claim 2 to sequentially display reviews in the sorted order to present first those reviews having the highest number of indications. Still further, nothing in the Decision on Appeal or NowThis suggests the feature added to claim 1 from dependent claim 8, namely the sending an error indication to the user if the user attempts to click the interactive element more than once. Claim 1, as amended, provides a combination of substantial features of the overall method that are neither shown nor suggested by NowThis. Merely adding one vote per person to NowThis does not necessarily result in the claimed method claim 1, as now amended.

The Board also affirmed the Examiner's rejection of the claims based upon a combination of EPinions and Salas, finding that the combination

"...shows or suggests one vote per person, and it shows or suggests votes applied toward rating usefulness or (sic?) product or service reviews."

Even if Applicant were to concede that characterization of the cited documents to be correct, the combination proposed by the Examiner does not show all of the features of claim 1, as now amended to include the subject matter of claims 2 and 8, since they do more to identify reviews than merely recognize the need for a "one vote per person" limiting feature.

As amended, claim 1 incorporates the features of claim 2 and 8 so that it also indicates the importance of some reviews over others by listing them in an order as a function of the number of indications tallied for each review and by sending an error to the user if the interactive element has been clicked by the user more than once for the review.

Although the Board affirmed the Examiner's rejection of the claims as obvious over Klingman, primarily on the grounds that

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<sup>1</sup> Appeals Decision, "Fact 08," page 6, lines 14-15

"...the nature of the textual material the votes apply to cannot define the invention over the art because the descriptive material is not functionally related to the substrate (see *Ngai*)."

Addition of the subject matter of claims 3 and 8 to the subject matter of claim 1 results in a combination neither shown nor suggested in the cited Klingman patent, the sole reference for this obviousness rejection.

Applicant also wishes to point out that the whatever the applicability of the holding in *Ngai* may be as to original claim 1 – it fails to negate the differences between the features of amended claim 1 and what was shown or suggested in either the combination of references or the single reference applied in the affirmed rejections of original claim 1. The present claims do not refer to "text on a substrate" as was the case in the quotation from *Ngai* paraphrased in the Board's conclusions<sup>2</sup>. As contrasted to "text on a substrate" incapable of distinguishing a kit from prior kits, the claims of the present application relate to a method of identifying what reviews of products may be helpful in a database coupled to a distributed communication network. The fact that the present claims are drawn to a method and system for characterizing reviews in a particular manner in response to user input does not make the distinctive features of the amended claims the sort of "nonfunctional descriptive material" that is mentioned in *Ngai* (as quoted from *Gulack*, which was distinguished in *Ngai*). The addition of the patentable features from dependent claims 2 and 8 further distinguishes the amended claims from any of the cited documents in any of the previous rejections.

Applicants suggest that consideration of the amended claims in the light of the previously cited art, the Appeals Decision and the law of the *Ngai* case compels reaching a conclusion that there is no *prima facie* basis to find their subject matter obvious over the prior art of record. Entry of the proposed amendment and prompt issuance of a Notice of Allowance is respectfully requested.

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<sup>2</sup> Decision on the present appeal, page, 10, lines 5-7 and 19-21.

**CONCLUSION**

Applicant respectfully submits that the amended claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6970 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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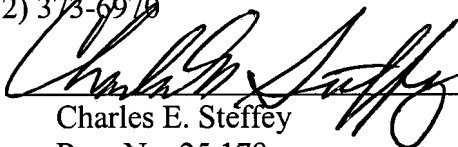
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Date

July 23, 2007

By



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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 23 day of July, 2007.

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Name

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Signature